

PATENT  
Atty. Dkt No. ROC920000066US1  
MPS Ref. No.: IBM2K0066

## REMARKS

This is intended as a full and complete response to the Office Action dated December 6, 2004, having a shortened statutory period for response set to expire on March 6, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 5-11 and 21-31 are pending in the application. Claims 5-9, 11 and 21-31 remain pending following entry of this response. Claims 5, 11, 21 and 26 have been amended. Claim 10 has been cancelled. Applicants submit that the amendments do not introduce new matter.

### Claim Rejections - 35 U.S.C. § 102

Claims 5-11, 21-24, 26-31 stand rejected under 35 U.S.C. 102(b) as being anticipated by *Hekmatpour* (US Patent No. 5,799,292; hereinafter *Hekmatpour*). Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Hekmatpour* does not disclose "each and every element as set forth in the claim". Specifically, at a minimum, *Hekmatpour* does not disclose positioning a Web page to ensure that desired page elements are viewable, as claimed.

*Hekmatpour* is directed to managing presentation of multiple hypermedia objects within a display window. See, col. 2, lines 18-27. Management of the objects is accomplished by automatically adjusting a display order of the multiple hypermedia objects within the display window. Col. 2, lines 30-34; emphasis added. In contrast, the present claims generally provide for positioning of a Web page on the basis of previous user interaction with the page. For example, claim 1 recites rendering a Web page by scrolling the page to a desired location according to a user interaction field in the page

PATENT  
Atty. Dkt. No. ROC920000066US1  
MPS Ref. No.: IBM2K0066

and claims 11, 21 and 26 recite positioning the Web page relative to a display screen to ensure that desired portions (user interaction fields) of the page are viewable. Applicants, therefore, submit that *Hekmatpour* does not teach positioning a Web page (whether by automatic scrolling or otherwise) on the basis of user interaction data/fields. In fact, *Hekmatpour* teaches away from such positioning of Web pages since *Hekmatpour* specifically requires that hypermedia objects be rearranged within a page, rather than repositioning the page. To this end, *Hekmatpour* requires that every hypermedia objects be assigned a weight (described as an Activation Frequency Coefficient (AFC), at col. 6, lines 3-4) on the basis of which the relative position of the objects within the page is determined. See, Figures 6a-c and corresponding text. Therefore, Applicants submit the claims are allowable and respectfully request allowance of the same.

With regard to claim 10 (now incorporated into independent claim 5) the Examiner argues that *Hekmatpour* teaches that rendering includes scrolling a page at column 7, lines 28-32; column 8, lines 65-67; and column 10, lines 22-39. Respectfully, the Examiner errs. Claim 5 recites scrolling as a component of page rendering, which is well-known as the computer implemented activity of generating an image on a screen. Thus, the scrolling in claim 5 is clearly an automated function, as is further supported by the concluding claim language of claim 5: "thereby eliminating a user of the networked client display device from having to reposition the page to bring the user interaction field into the viewable area." Thus, per claim 5 scrolling is used to advantage to render a page in a desired manner. In contrast, *Hekmatpour* teaches that scrolling is the conventional activity of a user who desires to view a particular portion of a page and *Hekmatpour* specifically teaches that scrolling is to be altogether eliminated. See, col. 7, lines 28-32. Therefore, *Hekmatpour* does not teach scrolling as a function of page rendering and in fact teaches that scrolling is to be eliminated.

The dependent claims are believed to be allowable by virtue of their dependence from a respective allowable independent claim. Accordingly, separate arguments with respect to the dependent claims are not necessary. However, at least claim 22 merits special and separate attention. Claim 22 recites determining that the one or more page elements are not positioned in the viewable area of the display for a default display

PATENT  
Atty. Dkt No. ROC920000086US1  
MPS Ref. No.: IBM2K0066

arrangement. The Examiner argues that the "determination of whether an object is in [sic] viewable area" is inherently taught by *Hekmatpour* at column 8, lines 38-40, column 7, lines 28-32 and column 8, lines 65-66. As an initial matter, Applicants respectfully note that the Examiner mischaracterizes the claim language. Claim 22 does not recite determining whether an object is in a viewable area as suggested by the Examiner; rather claim 22 recites determining that one or more page elements are not positioned in a viewable area. On this basis alone Applicants submit that the rejection is improper and should be withdrawn. Further, Applicants submit that in no sense does *Hekmatpour* make an explicit determination of whether an object is in a viewable area or outside of a viewable area. *Hekmatpour* clearly teaches that the relative positioning of hypermedia objects is determined on the basis of the respective AFC values for the objects. Consideration of whether an object is within or without a viewable area is neither inherent nor explicit in the management of objects according to *Hekmatpour*. Further, it is well established that an argument on the basis of inherency requires that the suggested inherent aspect necessarily be present. MPEP §2112 (IV). Since the hypermedia objects of *Hekmatpour* can be arranged exclusively with respect to their respective AFC values regardless of whether they are located within or without a viewable area (and, in fact, are so arranged), determining that one or more page elements are not positioned in a viewable area is not necessary. Accordingly, the rejection is improper and should be withdrawn. Therefore, Applicants submit that the claims are patentable over *Hekmatpour* and request allowance of the same.

Claim Rejections - 35 U.S.C. § 103

Claim 25 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *Hekmatpour*. Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or

**PATENT**  
Atty. Dkt. No. ROC920000086US1  
MPS Ref. No.: IBM2K0066

references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the third criterion. Specifically, *Hekmatpour* does not teach positioning a Web page as claimed. Therefore, Applicants submit that the claims are patentable over *Hekmatpour* and request allowance of the same.

Conclusion

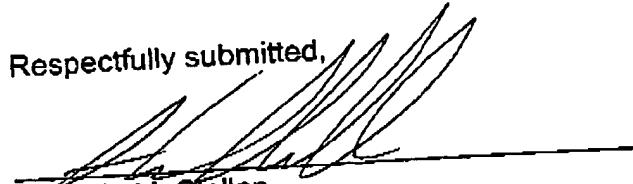
Applicants submit that all pending claims are now allowable. Further, Applicants believe the present amendment does not raise new issues requiring further search. In the case of claim 5, the amendment merely incorporated a dependent claim. In the case of claims 11 and 26 the amendments were made to make the claims consistent with corresponding language of claim 21. Further, by amending the claims to be specifically directed to positioning a Web page within a display, the issues for appeal have been simplified. Accordingly, Applicants submit that the amendments should be entered and the claims be allowed. If the Examiner maintains any of the amendments should not be entered, the Examiner is kindly requested to call the attorney signing below in an effort to come to an agreement that will allow prosecution to move forward.

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

PATENT  
Atty. Dkt. No. ROC920000066US1  
MPS Ref. No.: IBM2K0066

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,

  
Gero G. McClellan  
Registration No. 44,227  
MOSER, PATTERSON & SHERIDAN, L.L.P.  
3040 Post Oak Blvd. Suite 1500  
Houston, TX 77056  
Telephone: (713) 623-4844  
Facsimile: (713) 623-4846  
Attorney for Applicants